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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,325	01/31/2002	William Kress Bodin	AUS920010855US1	3989
34533	7590	07/22/2005	EXAMINER	
INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469			FISCHER, ANDREW J	
		ART UNIT		PAPER NUMBER
				3627

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/062,325	BODIN ET AL.	
	Examiner	Art Unit	
	Andrew J. Fischer	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 May 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-30 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

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DETAILED ACTION***Acknowledgements***

1. Applicants' response filed May 3, 2004 is acknowledged. Accordingly, claims 1-30 remain pending.
2. Regarding a potential restriction, the Examiner maintains that the inventions are not patentably distinct. Moreover, Applicants have not attempted to rebut this finding. The Examiner continues to rely on this finding. Because the inventions are not patentably distinct, a restriction is improper at this time.
3. All references in this Office Action to the capitalized versions of "Applicant(s)" refers specifically the Applicant(s) of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise , references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.
5. As noted in the previous office action (the "First Non Final Office Action" mailed February 3, 2005) in paragraph no. 6, this application in an image file wrapper ("IFW") application. Applicants' response is therefore separated before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner again highly recommends Applicants place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each*

page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See also 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181.

The claims are replete with these errors (these errors being objections to the specification for failing to provide proper antecedent basis for the claimed subject matter). Some examples follow:

- i. The “means for providing” as recited in claims 11 and 21.
- ii. The “means for detecting” as recited in claims 12 and 22.
- iii. The “means for reading” as recited in claims 14 and 24.

7. Additionally, the lengthy specification has not been checked to the extent necessary to determine the presence of *all* possible errors. Applicants’ cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC §112 2nd Paragraph

8. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-30 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. In claim 1, it is unclear if the “detecting changes” step detects changes to the attribute definitions (as claimed) or changes in the ‘values’ of the attributes. In other words, what “changes” are being detected? Are there changes to the attribute definition or type of attribute, a value of the attribute, or some other change?
 - b. In claim 11 and 21, it is unclear what is the corresponding structure in the “means for detecting changes . . .” In particular, it is unclear which hardware and/or software elements make up the “means for detecting changes . . .”
 - c. Also in claim 12, the term “OSGI” is indefinite. If Applicants expressly state on the record that such a term is old and well known in the art and Applicants provide appropriate evidence in support thereof, this particular 35 U.S.C. §112, 2nd paragraph rejection will be withdrawn.
10. Regarding the “means for” phrases: the Examiner again reiterates his position as noted previously, *i.e.* in the First Non Final Action:

To help maintain compact prosecution, to avoid additional 35 U.S.C. §112, 2nd paragraph rejections, and (if necessary) to aid Applicants in the event they appeal to the USPTO’s Board of Patent Appeals and Inferences, the Examiner recommends Applicants review their claims and for every means plus function or step plus function invoking 35 U.S.C. §112 6th paragraph and identified by Applicants, Applicants should indicate the claimed function in addition to expressly setting forth the corresponding structure, material, or acts of the particular claimed function by referring to the specification by page and line number and/or drawings with reference to particular characters noted therein. Applicants should consider this actual notice that such review and indication as described in this paragraph should be made prior to *any* amendment to the claims. However if Applicants have previously indicated the claimed function and the corresponding structure, material, or acts corresponding to that function, Applicants need only point out their response (with reasonable particularity) in which the indication was made.¹

¹ First Non Final Office Action, Page 5, Paragraph No. 11.

11. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694)(“Reber”). Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory items attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with

acceptable values, and takes action if those actions are outside a range (e.g. if a refrigerated item has a temperature which is outside an acceptable range, notification is made).

Claim Rejections - 35 USC §103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 11-20, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Reber.² It is the Examiner's principle position that the claims are anticipated because of the RFID identification tag code field is inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an RFID identification tag code field. Such a modification would have made it clear that RFID tags require unique ID numbers in order to properly identify the tag.

16. It is the Examiner's position that 'out-of-range' indicators in RF tag devices is old and well known in the art. Evidence to support this includes but is not limited to Friedman et. al. (U.S. 6,593,845 B1) column 5, ~ lines 64-67.

² See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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17. Claims 1-10 and 21-30, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Reber. Because Inventions I and III are not patentably distinct from Invention II, the patentability of Inventions I and III as currently claimed stands or falls with the patentability of Invention II.

18. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵ Third, after receiving express notice in the previous Office Action of the Examiner's position that

³ See the First Non Final Office Action (mailed February 3, 2005), Paragraph No. 17.

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

lexicography is not invoked.⁶ Applicants have not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation⁷ to be their own lexicographer.⁸ It remains the Examiner’s position that these requirements were reasonable.⁹ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and except for the application of 35 U.S.C. §112 6th paragraph), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re*

⁶ See again the First Non Final Office Action, Paragraph No. 17.

⁷ Id.

⁸ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants’ failure to correct the examiner’s characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner’s express invitation to correct a possible error in claim interpretation: “applicant’s attention was called to the examiner’s interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner’s interpretation—an invitation the applicant did not accept.”).

⁹ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed July 18, 2005).

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Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).¹⁰ The Examiner now relies heavily and extensively on this interpretation.¹¹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

19. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹²) during ex parte examination.

20. The Examiner maintains his position that claims 11-30 are product or machine claims. Applicants' arguments have been considered but are not persuasive.

¹⁰ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

¹¹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]"

¹² See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

Response to Arguments

21. Applicants' arguments filed May 3, 2005 have been fully considered but they are not persuasive.
22. The Examiner maintains his objections to the specification. Applicants arguments are not persuasive because MPEP §2181 expressly indicates the procedure for Applicants to follow regarding these objections.
23. The Examiner maintains his position on the 35 U.S.C. §112 2nd paragraph rejections. In particular, the reason for the Examiner states that the claims are replete with errors is because it is quite clear that the claims contain at least three (3) 35 U.S.C. §112 2nd paragraph errors. Applicants have not made a reasonable attempt at addressing these errors.
24. Regarding the 35 U.S.C. §112 2nd paragraph and its relation to 35 U.S.C. §112 6th paragraph, it is the Examiner's factual determination that it would not be unreasonable for applicants to assume that Applicant must point out the corresponding structure in all phrases that potentially invoke 35 U.S.C. §112 6th paragraph. See Paragraph No. 10, supra. Moreover, it is the Examiner's position that the law is clear on this point.

The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express the claim in terms of function under section 112, paragraph 6. Section 112, paragraph 6 was intended to allow the use of means expressions in patent claims without requiring the patentee to recite in the claims all possible structures that could be used as means in the claimed apparatus. However, the price that must be paid for use of that convenience is limitation of the claim to the means specified in the written description and equivalents thereof. If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid that price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification. Such is impermissible under the statute. *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003)(citations and quotations omitted).

25. Regarding the term “OSGI,” the Examiner maintains his position that the term is indefinite. It is the Examiner’s position that OSGI is indefinite on its face because looking at the claim alone, one of ordinary skill in the art can not reasonably understand what is meant by OSGI. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted).

26. Regarding Applicants’ discussion of *Verdegall Bros. v. Union Oil*, the Examiner notes that *Verdegall Bros.* was an inter partes infringement case. This is ex parte examination. It is the Examiner’s position therefore the that *Verdegall Bros.* is not necessary controlling.

27. Because the claims are indefinite, they can not be construed. See Paragraph No. 11, *supra*. It is therefore impossible to tell whether the “means for” phrases are present in the reference.

28. Regarding Applicants’ enablement arguments, they too are not persuasive because Applicants have not presented clear and convincing evidence that Reber is not enabled.

29. It is the Examiner’s factual determination that conventional non-volatile memory of an RF-tag contains at least two sections. The first memory contains a unique tag identification number and other data such as, e.g. UPC code and price. The second memory is a ‘flag.’ Evidence to support this conclusion includes *e.g.* Cofino et. al. (U.S. 5,966,082) column 4, lines 39-63.

30. The Examiner maintains his position on inherency. It is the Examiner’s factual determination that the natural flowing result of the functions of tag 30 in Reber discloses a tag code field and attributes. This is reasonable because the tags need to be

differentiated. If a tag does not have a tag code field with attributes, the system would be unable to recognize one tag from another. Moreover, because conventional RF tags contain e.g. UPC information, they have attributes.

31. Applicants argue that “the Examiner has made a mere naked assertion that a bar code tags (sic) and RFID tags are recognized equivalents in the prior art with no objective evidence of record.”¹³ The Examiner maintains his position that bar code tags and RF tags are art recognized equivalents. See the First Final Office Action, Page 12, Paragraph No. 21. Additionally, Applicants’ arguments that the Examiner has made such conclusions with “no evidentiary support”¹⁴ with “absolutely no ‘objective evidence of record’”¹⁵ have been considered but are not persuasive. Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of

¹³ Applicants’ Remarks, Page 34, 1st sentence.

¹⁴ Applicants’ Remarks, Page 33, last paragraph.

¹⁵ Applicants’ Remarks, Page 28, middle paragraph.

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a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record, if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicants' response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

32. The Examiner confirms that claims 1-30 do not recite any product-by-process limitations. See the First Final Office Action, Paragraph No. 22 and Applicants' response on page 35 of their Remarks.”

33. Applicants' argument stating that “the Office Action makes no mention whatsoever of any evidence of suggest or motivation to modify Reber”¹⁶ has been considered but is not persuasive because the Examiner expressly stated in both the First Non Final Office Action and this Office Action that “Such a modification would have

¹⁶ Applicants' Remarks, Page 30, middle paragraph.

made it clear that RFID tags require unique ID numbers in order to properly identify the tag.”

34. Applicants arguments with respect to ‘Expectation of Success’ have been considered but are not persuasive because such technology is old and well known. See again *e.g.* Cofino and the other art of record.

35. As for what is anticipation, “It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim” *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986).

36. Regarding Applicants’ arguments of anticipation, Applicants are respectfully reminded that during ex parte examination, anticipation requires the Examiner to meet the ‘All Elements Test.’ “It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question” *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); see also *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”). In other words, all elements of the claimed invention must be disclosed in some fashion for the claim to be anticipated. Logically, the lack of a single element would negate anticipation. “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). Yet it is important to keep in mind that “[a]n anticipatory reference, however, need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369,

21 USPQ2d 1321, 1328 (Fed. Cir. 1991). “While a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests . . .” *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) (citations and quotations omitted).¹⁷ In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).¹⁸

However, anticipation is also based upon a *combination* of a prior art reference and the knowledge of one of ordinary skill in the art. “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962). See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*. Applicants’ arguments regarding anticipation have been fully considered but because those arguments fail to account for or consider the skilled artisan’s ‘knowledge of the particular art’ in *combination* with a reference, such arguments are not persuasive.

¹⁷ See also *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965)(noting that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests).

¹⁸ See MPEP §2123, Subsection titled “Patents Are Relevant as Prior Art for All They Contain.”

Conclusion

37. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

38. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

39. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

41. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

42. Also in accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434, the Examiner additionally finds that the Borland's Paradox for Windows User's Guide is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Paradox for Windows User's Guide exemplifies a typical relational database system. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical),

the Examiner finds that the Paradox for Windows User's Guide is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference.

43. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

44. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position

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regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (beginning on page 2) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁹ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.

Handwritten signature of Andrew J. Fischer in cursive ink, followed by the date 7/18/05.

Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
July 18, 2005

¹⁹ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.